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Attorneys for Plaintiff
DIGBY ADLER GROUP d/b/a BANDAGO

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

**DIGBY ADLER GROUP LLC d/b/a
BANDAGO**, a California limited liability
company,

Plaintiff,

vs.

IMAGE RENT A CAR, INC., a New York
corporation, and **VAN RENTAL CO.,
INC.**, a New York corporation,

Defendants.

Case No.

**COMPLAINT FOR
CYBERSQUATTING, TRADEMARK
INFRINGEMENT, UNFAIR
COMPETITION, AND FALSE
ADVERTISING**

DEMAND FOR JURY TRIAL

Case No.

COMPLAINT

KRONENBERGER BURGOYNE, LLP
150 Post Street, Suite 520
San Francisco, CA 94108
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ORIGINAL
FILED
2010 FEB 11 P 3:28
RICHARD W. MEIKEN
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
E-filing

SC

CV 10 617

1 Plaintiff Digby Adler Group LLC d/b/a Bandago ("Plaintiff"), through its attorneys,
2 alleges as follows:

3 JURISDICTION AND VENUE

4 1. This Court has subject matter jurisdiction over this action under 28 U.S.C. §
5 1331 (federal question). Supplemental jurisdiction over claims arising under the law of
6 the State of California is conferred upon this Court under 28 U.S.C. § 1367
7 (supplemental jurisdiction).

8 2. On information and belief, this Court has personal jurisdiction over
9 defendants Image Rent A Car ("IRAC") and Van Rental Co., Inc. ("VRC") (collectively,
10 "Defendants") because Defendants advertise and/or market their services to clients and
11 potential clients located in California, provide van rentals for use throughout the entire
12 United States, including for use in California, knew that their actions alleged herein were
13 directed at and would and did cause harm to a California entity, and their actions harmed
14 California consumers.

15 3. Venue is proper pursuant to 28 U.S.C. §1391 because a substantial part of
16 the events or omissions, and consumer confusion, giving rise to Plaintiff's claim occurred
17 within the District. Plaintiff is based in the District and suffered the harm here.

18 PARTIES

19 4. Plaintiff is, and at all times herein mentioned was, a California limited
20 liability company organized and existing under the laws of California, with its principal
21 place of business at 2200 Cesar Chavez St., Suite 16, San Francisco, California.

22 5. Upon information and belief, defendant IRAC is and at all times herein
23 mentioned was, a New York corporation organized and existing under the laws of New
24 York, with its principal place of business at 391 Empire Blvd., Brooklyn, New York.

25 6. Upon information and belief, defendant VRC is and at all times herein
26 mentioned was, a New York corporation organized and existing under the laws of New
27 York, with its principal place of business at the same location as defendant IRAC's
28 principal place of business, 391 Empire Blvd., Brooklyn, New York.

1 7. Upon information and belief, Defendants at all relevant times and in
2 connection with all relevant acts herein, operated as a joint venture, and/or acted as the
3 agent of the other with the advance knowledge, acquiescence, or subsequent ratification
4 of the acts of the other.

5 8. Whenever in this Complaint reference is made to any act of Defendants,
6 that allegation shall be deemed to mean that its officers, directors, agents, employees or
7 representatives, committed, conspired to commit, authorized, aided, abetted, furnished
8 the means to, advised or encouraged the acts alleged, while actively engaged in the
9 management, direction or control of the affairs of that defendant.

10 **INTRADISTRICT ASSIGNMENT**

11 9. For the purposes of Local Rule 3-2(c), this action should be assigned to the
12 San Francisco division of the Court because San Francisco is the county in which a
13 substantial part of the events or omissions which give rise to the claims occurred.

14 **FACTUAL ALLEGATIONS**

15 10. Plaintiff, founded in 2002, rents cars and vans, including 15-passenger
16 vans and Dodge "Sprinter" vans for tours, groups, and extended travel and long-term
17 use.

18 11. Plaintiff's principal offices are located in San Francisco, California, and it
19 has rental locations in California, New Jersey, Illinois, and Oregon. Plaintiff provides van
20 rentals for use throughout the entire United States.

21 12. Plaintiff has been doing business under the fictitious name and service
22 mark "Bandago" (the "Mark") since 2003, and first used the Mark in commerce on or
23 about August 15, 2003. On May 27, 2008, Plaintiff filed an application to register the
24 Mark with the United States Patent and Trademark Office (Serial Number 77484380).
25 The Mark has not yet been registered, but publication period has been completed and
26 Plaintiff expects the application to proceed to registration shortly.

27 13. On or about August 7, 2003, Plaintiff registered the domain name
28 bandago.com for use in connection with its car and van rental business.

14. Plaintiff has invested significant resources into building its brand name and reputation under the Mark through advertising and marketing, including building and maintaining the website www.bandago.com. Plaintiff has used the Mark continuously and exclusively since 2003.

15. On information and belief, Defendants are in substantially the same business as Plaintiff, renting cars and vans, including 15-passenger vans and Dodge “Sprinter” vans for tours, groups, and extended travel and long-term use. Notably, Plaintiff and Defendants are some of the only companies to rent Dodge “Sprinter” vans in the country, and such vans are in high demand and attract corporate clients who can spend in excess of six figures renting them.

16. On information and belief, Defendants’ principal offices are in New York and have rental locations in New York, New Jersey, and Florida. On information and belief, Defendants provide van rentals for use throughout the entire United States, including for use in California.

17. On information and belief, Defendants own and operate the website imagerentacar.com.

18. On information and belief, Defendants advertise and/or market their services to clients and potential clients located in California.

19. On information and belief, on or about August 28, 2008, defendant VRC registered the domain name bandago.net.

20. On information and belief defendant VRC was acting as the agent of defendant IRAC and registered the domain name for its and IRAC’s use, or subsequently transferred or shared ownership and control, via license or otherwise, of the domain name to/with IRAC.

21. On information and belief, Defendants created a website at their domain bandago.net that automatically and immediately redirected visitors to defendant IRAC’s website, imagerentacar.com.

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22. On information and belief, Defendants do not, and have never had, any trademark or intellectual property rights in the name “Bandago.”

23. On information and belief, the domain name bandago.net does not consist of any name commonly used to identify Defendants.

24. On information and belief, other than in registering the domain name bandago.net and redirecting visitors from bandago.net to their own website, Defendants have never used the name “Bandago” in commerce or in connection with any bona fide offering of any goods or services.

25. On information and belief, Defendants registered the domain name bandago.net with the intent to divert Plaintiff’s actual or potential customers to Defendants’ website with the desire and intent that those redirected customers use Defendants’ services instead of Plaintiff’s.

26. Defendants’ domain name bandago.net is confusingly similar to Plaintiff’s Mark and Plaintiff’s website bandago.com; except for the top level domains (*i.e.*, “.com” and “.net”), Defendants’ domain name is identical to Plaintiff’s Mark and website.

27. Defendants’ website bandago.net caused actual confusion among members of the public between Defendants’ and Plaintiff’s websites and services.

28. On information and belief, actual or potential customers were actually deceived by Defendants’ use of the domain name bandago.net into using Defendants’ services instead of Plaintiff’s services.

29. On information and belief, Defendants registered the domain name bandago.net knowing that Plaintiff provided similar services under the Mark and via its own website bandago.com and knowing that it would likely harm Plaintiff. On information and belief, Defendants took these actions also knowing that Plaintiff’s principal place of business was in California and that such actions would likely harm Plaintiff in California.

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FIRST CLAIM FOR RELIEF

Cybersquatting [Lanham Act § 43(d); 15 USC § 1125(d)(1)]

30. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-29, as if fully alleged herein.

31. Plaintiff is the owner of the Mark.

32. The Mark is distinctive.

33. Defendant, in bad faith, intended to profit from the Mark by registering, trafficking in, and/or using the domain name bandango.net, which contains the Mark.

34. At the time Defendant registered the domain name www.bandango.net, it was identical, or confusingly similar, to the Mark.

35. As a direct and proximate result of Defendant's actions, conduct, and practices alleged above, Plaintiff has been damaged and will continue to be damaged.

36. Defendants' acts have also caused and are causing irreparable and incalculable injury to Plaintiff and its Mark, and to the business and goodwill represented thereby, and unless enjoined, will cause further irreparable and incalculable injury, whereby Plaintiff has no adequate remedy at law.

SECOND CLAIM FOR RELIEF

Unfair Competition [Lanham Act § 43(a), 15 U.S.C. § 1125(a)]

37. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-36, as if fully alleged herein.

38. Plaintiff is the owner of the Mark.

39. The Mark is distinctive.

40. Defendants registered and used in commerce the domain name bandago.net.

41. Defendants' registration and use in commerce of the domain name bandago.net, including its redirecting of visitors to bandago.net to Defendants' website, is likely to cause confusion, to cause mistake, or to deceive members of the public,

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1 including potential and current clients of Plaintiff, as to the source and origin of the
2 services offered and to be offered by Defendants under the domain name bandago.net.

3 42. Defendants' registration and use in commerce of the domain name
4 bandago.net constitutes trademark infringement of Plaintiff's common law trademark
5 rights in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

6 43. As a direct and proximate result of Defendant's actions, conduct, and
7 practices alleged above, Plaintiff is likely to be and has been damaged and will continue
8 to be damaged.

9 44. Defendants' acts have also caused and are causing irreparable and
10 incalculable injury to Plaintiff and its Mark, and to the business and goodwill represented
11 thereby, and unless enjoined, will cause further irreparable and incalculable injury,
12 whereby Plaintiff has no adequate remedy at law.

13 **THIRD CLAIM FOR RELIEF**

14 **False Advertising [Lanham Act § 43(a), 15 U.S.C. § 1125(a)(1)(B)]**

15 45. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-44, as if
16 fully alleged herein.

17 46. Plaintiff is the owner of the Mark.

18 47. The Mark is distinctive.

19 48. Defendants registered and used in commerce the domain name
20 bandago.net.

21 49. Defendants' registration and use in commerce of the domain name
22 bandago.net, including its redirecting of visitors to bandago.net to Defendants' website,
23 constitutes commercial advertising or promotion within the meaning of Section
24 43(a)(a)(B) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

25 50. Defendants' registration and use in commerce of the domain name
26 bandago.net misrepresents the nature, characteristics, and qualities of Defendants' and
27 Plaintiff's goods, services, and commercial activities.

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1 51. As a direct and proximate result of Defendant's actions, conduct, and
2 practices alleged above, Plaintiff is likely to be and has been damaged and will continue
3 to be damaged.

4 52. Defendants' acts have also caused and are causing irreparable and
5 incalculable injury to Plaintiff and its Mark, and to the business and goodwill represented
6 thereby, and unless enjoined, will cause further irreparable and incalculable injury,
7 whereby Plaintiff has no adequate remedy at law.

8 **FOURTH CLAIM FOR RELIEF**

9 **Common Law Trademark Infringement**

10 53. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-52, as if
11 fully alleged herein.

12 54. Plaintiff is the owner of the Mark.

13 55. The Mark is distinctive.

14 56. Plaintiff used the Mark in commerce continuously and exclusively prior to
15 Defendants' use of the Mark.

16 57. Defendants' registration and use in commerce of the domain name
17 bandago.net, including its redirecting of visitors to bandago.net to Defendants' website, is
18 likely to cause confusion, to cause mistake, or to deceive members of the public,
19 including potential and current clients of Plaintiff, as to the source and origin of the
20 services offered and to be offered by Defendants under the domain name bandago.net
21 and to cause members of the public to confuse Defendants' use of "bandago" with
22 Plaintiff's Mark.

23 58. As a direct and proximate result of Defendant's actions, conduct, and
24 practices alleged above, Plaintiff has been damaged and will continue to be damaged.

25 59. In committing the conduct and acts alleged herein, Defendants have acted
26 despicably, and have been guilty of oppression, fraud, and/or malice, and acted with a
27 willful and conscious disregard for Plaintiff's rights, and with intent to deceive.

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FIFTH CLAIM FOR RELIEF

Unlawful, Unfair, or Fraudulent Business Practices [Cal. Bus. & Prof. C. § 17200]

60. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-59, as if fully alleged herein.

61. Plaintiff is the owner of the Mark.

62. The Mark is distinctive.

63. Defendants' registration and use in commerce of the domain name bandago.net, including its redirecting of visitors to bandago.net to Defendants' website, are unlawful business practices in violation of Sections 43(a) and 43(d) of the Lanham Act.

64. Defendants' registration and use in commerce of the domain name bandago.net, including its redirecting of visitors to bandago.net to Defendants' website, are unfair and/or fraudulent business practices that are designed to deceive, confuse, and misguide members of the public, including Plaintiff's actual and potential customers, as to owner of the Bandago brand and the source of services provided under the Bandago brand, and are designed to siphon, redirect, and improperly take Plaintiff's actual and potential customers for Defendants' own commercial gain and to the detriment of Plaintiff.

65. As a direct and proximate result of Defendant's actions, conduct, and practices alleged above, Defendants have acquired improper commercial benefits and Plaintiff has been damaged and will continue to be damaged.

66. In committing the conduct and acts alleged herein, Defendants have acted despicably, and have been guilty of oppression, fraud, and/or malice, and acted with a willful and conscious disregard for Plaintiff's rights, and with intent to deceive.

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PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests judgment as follows:

1. That the Court enter judgment against the Defendant that it has
 - a. Committed and is committing cybersquatting in violation of 15 U.S.C. §1125(d);
 - b. Committed and is committing acts of infringement of an unregistered trademark and unfair competition in violation of 15 U.S.C. §1125(a);
 - c. Committed and is committing acts of infringement of Plaintiff's trademark under California law;
 - d. Committed and is committing acts of unfair competition in violation of California Business & Professions Code section 17200.
2. That the Court issue injunctive relief against Defendant, requiring Defendant to transfer the domain name bandango.net to Plaintiff.
3. That the Court order Defendant to pay Plaintiff's damages as follows:
 - a. The greater of Plaintiff's damages (composed of Plaintiff's actual damages and Defendant's profits) in an amount to be determined according to proof pursuant to or Plaintiff's statutory damages of \$100,000 pursuant to 15 U.S.C. §1117(a), (d).
 - b. Plaintiff's damages (composed of Plaintiff's actual damages and Defendant's profits) in an amount to be determined according to proof pursuant to 15 U.S.C. §1117(a) for Defendant's willful infringement of Plaintiff's unregistered trademark;
 - c. Plaintiff's restitutionary damages for Defendant's violation of California Business and Professions Code section 17200.
 - d. Such other damages as the Court shall deem appropriate;
 - e. Interest, including prejudgment interest, on the foregoing sums;

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4. That the Court grant to Plaintiff such additional relief as is just and proper.

Respectfully Submitted,

DATED: February 11, 2010.

KRONENBERGER BURGOYNE, LLP

By: 

Karl S. Kronenberger

Attorneys for Plaintiff DIGBY ADLER
GROUP d/b/a BANDAGO

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1 **REQUEST FOR JURY TRIAL**

2 Plaintiff hereby demands a trial of this action by jury.

3
4 DATED: February 11, 2010.

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6 **KRONENBERGER BURGOYNE, LLP**

7
8 By: 

9 Karl S. Kronenberger

10 Attorneys for Plaintiff DIGBY ADLER
11 GROUP d/b/a BANDAGO
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JS 44 (Rev. 12/07) (CAND Rev 1/10)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON PAGE TWO OF THE FORM.)

I. (a) PLAINTIFFS

Digby Adler Group LLC d/b/a Bandago, a California limited liability company,

(b) County of Residence of First Listed Plaintiff San Francisco, California
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Karl S. Kronenberger
Kronenberger Burgoyne, LLP
150 Post Street, Suite 520, San Francisco, CA 94108
(415) 955-1155

DEFENDANTS

Image Rent A Car, Inc., a New York corporation, and Van Rental Co. Inc., a New York corporation,

County of Residence of First Listed Defendant Kings, New York
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
☒ 3 Federal Question (U.S. Government Not a Party)
☐ 2 U.S. Government Defendant
☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT		TORTS		FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance	<input type="checkbox"/> 310 Airplane	<input type="checkbox"/> 362 Personal Injury—	<input type="checkbox"/> 610 Agriculture	<input type="checkbox"/> 422 Appeal 28 USC 158	<input type="checkbox"/> 400 State Reapportionment	
<input type="checkbox"/> 120 Marine	<input type="checkbox"/> 315 Airplane Product Liability	<input type="checkbox"/> 365 Personal Injury—	<input type="checkbox"/> 620 Other Food & Drug	<input type="checkbox"/> 423 Withdrawal 28 USC 157	<input type="checkbox"/> 410 Antitrust	
<input type="checkbox"/> 130 Miller Act	<input type="checkbox"/> 320 Assault, Libel & Slander	<input type="checkbox"/> 368 Asbestos Personal Injury Product Liability	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881		<input type="checkbox"/> 430 Banks and Banking	
<input type="checkbox"/> 140 Negotiable Instrument	<input type="checkbox"/> 330 Federal Employers' Liability	<input type="checkbox"/> 370 Other Fraud	<input type="checkbox"/> 630 Liquor Laws		<input type="checkbox"/> 450 Commerce	
<input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment	<input type="checkbox"/> 340 Marine	<input type="checkbox"/> 371 Truth in Lending	<input type="checkbox"/> 640 R.R. & Truck		<input type="checkbox"/> 460 Deportation	
<input type="checkbox"/> 151 Medicare Act	<input type="checkbox"/> 345 Marine Product Liability	<input type="checkbox"/> 380 Other Personal Property Damage	<input type="checkbox"/> 650 Airline Regs.		<input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations	
<input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans)	<input type="checkbox"/> 350 Motor Vehicle	<input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 660 Occupational Safety/Health		<input type="checkbox"/> 480 Consumer Credit	
<input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits	<input type="checkbox"/> 355 Motor Vehicle Product Liability		<input type="checkbox"/> 690 Other		<input type="checkbox"/> 490 Cable/Sat TV	
<input type="checkbox"/> 160 Stockholders' Suits	<input type="checkbox"/> 360 Other Personal Injury				<input type="checkbox"/> 810 Selective Service	
<input type="checkbox"/> 190 Other Contract					<input type="checkbox"/> 850 Securities/Commodities/Exchange	
<input type="checkbox"/> 195 Contract Product Liability					<input type="checkbox"/> 875 Customer Challenge 12 USC 3410	
<input type="checkbox"/> 196 Franchise					<input type="checkbox"/> 890 Other Statutory Actions	
					<input type="checkbox"/> 891 Agricultural Acts	
					<input type="checkbox"/> 892 Economic Stabilization Act	
					<input type="checkbox"/> 893 Environmental Matters	
					<input type="checkbox"/> 894 Energy Allocation Act	
					<input type="checkbox"/> 895 Freedom of Information Act	
					<input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice	
					<input type="checkbox"/> 950 Constitutionality of State Statutes	

REAL PROPERTY	CIVIL RIGHTS	PRISONER PETITIONS	LABOR	SOCIAL SECURITY	FEDERAL TAX SUITS
<input type="checkbox"/> 210 Land Condemnation	<input type="checkbox"/> 441 Voting	<input type="checkbox"/> 510 Motions to Vacate Sentence	<input type="checkbox"/> 710 Fair Labor Standards Act	<input type="checkbox"/> 861 HIA (1395ff)	<input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant)
<input type="checkbox"/> 220 Foreclosure	<input type="checkbox"/> 442 Employment	<input type="checkbox"/> 530 General	<input type="checkbox"/> 720 Labor/Mgmt. Relations	<input type="checkbox"/> 862 Black Lung (923)	<input type="checkbox"/> 871 IRS—Third Party 26 USC 7609
<input type="checkbox"/> 230 Rent Lease & Ejectment	<input type="checkbox"/> 443 Housing/Accommodations	<input type="checkbox"/> 535 Death Penalty	<input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act	<input type="checkbox"/> 863 DIWC/DIWW (405(g))	
<input type="checkbox"/> 240 Torts to Land	<input type="checkbox"/> 444 Welfare	<input type="checkbox"/> 540 Mandamus & Other	<input type="checkbox"/> 740 Railway Labor Act	<input type="checkbox"/> 864 SSID Title XVI	
<input type="checkbox"/> 245 Tort Product Liability	<input type="checkbox"/> 445 Amer. w/Disabilities - Employment	<input type="checkbox"/> 550 Civil Rights	<input type="checkbox"/> 790 Other Labor Litigation	<input type="checkbox"/> 865 RSI (405(g))	
<input type="checkbox"/> 290 All Other Real Property	<input type="checkbox"/> 446 Amer. w/Disabilities - Other	<input type="checkbox"/> 555 Prison Condition	<input type="checkbox"/> 791 Empl. Ret. Inc. Security Act		
	<input type="checkbox"/> 440 Other Civil Rights				

V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
☐ 2 Removed from State Court
☐ 3 Remanded from Appellate Court
☐ 4 Reinstated or Reopened
☐ 5 Transferred from another district (specify)
☐ 6 Multidistrict Litigation
☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
15 USC § 1125(d)(1); 15 USC § 1125(a); 15 USC § 1125(a)(1)(B);

Brief description of cause:

Cybersquatting; Unfair Competition; False Advertising

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23
DEMAND \$ TBD

CHECK YES only if demanded in complaint:
JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

PLEASE REFER TO CIVIL L.R. 3-12 CONCERNING REQUIREMENT TO FILE "NOTICE OF RELATED CASE". N/A

IX. DIVISIONAL ASSIGNMENT (CIVIL L.R. 3-2)
(PLACE AND "X" IN ONE BOX ONLY)

☒ SAN FRANCISCO/OAKLAND
☐ SAN JOSE
☐ EUREKA

DATE

SIGNATURE OF ATTORNEY OF RECORD

February 11, 2010

KRONENBERGER BURGOYNE, LLP

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Henry M. Burgoyne III (Bar No. 203748)
Jeffrey M. Rosenfeld (Bar No. 222187)
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Attorneys for Plaintiff
DIGBY ADLER GROUP d/b/a BANDAGO

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

**DIGBY ADLER GROUP LLC d/b/a
BANDAGO**, a California limited liability
company,

Plaintiff,

vs.

IMAGE RENT A CAR, INC., a New York
corporation, **VAN RENTAL CO., INC.**, a
New York corporation, **GAD SEBAG**, an
individual, and **SHNEIOR ZILBERMAN**,
an individual,

Defendants.

Case No. Case No. 10-CV-00617-SC

FIRST AMENDED COMPLAINT FOR:

- CYBERSQUATTING,
- TRADEMARK INFRINGEMENT,
- UNFAIR COMPETITION,
- FALSE ADVERTISING, AND
- COPYRIGHT INFRINGEMENT

DEMAND FOR JURY TRIAL

1 Plaintiff Digby Adler Group LLC d/b/a Bandago ("Plaintiff"), through its attorneys,
2 alleges as follows:

3 JURISDICTION AND VENUE

4 1. This Court has subject matter jurisdiction over this action under 28 U.S.C.
5 §1331 (federal question) and 28 U.S.C. §1338. Supplemental jurisdiction over claims
6 arising under the law of the State of California is conferred upon this Court under 28
7 U.S.C. § 1367 (supplemental jurisdiction).

8 2. On information and belief, this Court has personal jurisdiction over
9 defendants Image Rent A Car ("IRAC") and Van Rental Co., Inc. ("VRC") because
10 Defendants advertise and/or market their services to clients and potential clients located
11 in California, provide van rentals for use throughout the entire United States, including for
12 use in California, knew that their actions alleged herein were directed at and would and
13 did cause harm to a California entity, and their actions harmed California consumers. On
14 information and belief, this Court has personal jurisdiction over defendants Shneior
15 Zilberman and Gad Sebag because they knew that their actions alleged herein were
16 directed at and would and did cause harm to a California entity, and that their actions
17 harmed California consumers.

18 3. Venue is proper pursuant to 28 U.S.C. §1391 because a substantial part of
19 the events or omissions, and consumer confusion, giving rise to Plaintiff's claim occurred
20 within the District. Plaintiff is based in the District and suffered the harm here.

21 PARTIES

22 4. Plaintiff is, and at all times herein mentioned was, a California limited
23 liability company organized and existing under the laws of California, with its principal
24 place of business at 2200 Cesar Chavez St., Suite 16, San Francisco, California.

25 5. Upon information and belief, defendant IRAC is and at all times herein
26 mentioned was, a New York corporation organized and existing under the laws of New
27 York, with its principal place of business at 391 Empire Blvd., Brooklyn, New York.
28

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6. Upon information and belief, defendant VRC is and at all times herein mentioned was, a New York corporation organized and existing under the laws of New York, with its principal place of business at the same location as defendant IRAC's principal place of business, 391 Empire Blvd., Brooklyn, New York.

7. Upon information and belief, defendant Sebag is an individual residing in New York.

8. Upon information and belief, defendant Zilberman is an individual residing in New York.

9. Upon information and belief, Defendants at all relevant times and in connection with all relevant acts herein, operated as a joint venture, and/or acted as the agent of the others with the advance knowledge, acquiescence, or subsequent ratification of the acts of the other.

10. Whenever in this Complaint reference is made to any act of a Defendant, that allegation shall be deemed to mean that it and/or officers, directors, agents, employees or representatives, committed, conspired to commit, authorized, aided, abetted, furnished the means to, advised or encouraged the acts alleged.

INTRADISTRICT ASSIGNMENT

11. For the purposes of Local Rule 3-2(c), this action should be assigned to the San Francisco division of the Court because San Francisco is the county in which a substantial part of the events or omissions which give rise to the claims occurred.

FACTUAL ALLEGATIONS

Plaintiff's Business and Plaintiff's BANDAGO Mark

12. Plaintiff, founded in 2002, rents cars and vans, including 15-passenger vans and Dodge "Sprinter" vans for tours, groups, and extended travel and long-term use.

13. Plaintiff's principal offices are located in San Francisco, California, and it has rental locations in California, New Jersey, Illinois, and Oregon. Plaintiff provides van rentals for use throughout the entire United States.

1 14. Plaintiff has been doing business under the fictitious name and service
2 mark “Bandago” (the “Mark”) since 2003, and first used the Mark in commerce on or
3 about August 15, 2003.

4 15. On or about August 7, 2003, Plaintiff registered the domain name
5 bandago.com for use in connection with its car and van rental business.

6 16. On August 31, 2010 Plaintiff obtained federal trademark registration for the
7 mark, BANDAGO, for use in connection with rental of passenger cars and vans,
8 Registration No. 3839689.

9 17. Plaintiff has invested significant resources into building its brand name and
10 reputation under the Mark through advertising and marketing, including building and
11 maintaining the website www.bandago.com. Plaintiff has used the Mark continuously
12 and exclusively since 2003.

13 18. Plaintiff has also invested significant time and money in developing
14 Plaintiff’s website, located at <www.bandago.com> (“Plaintiff’s Website”).

15 19. In particular, Plaintiff has invested significant time and money in drafting the
16 text that appears on the Plaintiff’s Website, so that the text is easily understandable by
17 customers and potential customers, and so that the text triggers optimal search engine
18 listings.

19 20. Plaintiff’s Website—and the text that appears on Plaintiff’s Website—are
20 original, creative works in which Plaintiff owns protectable copyright interests.

21 21. Plaintiff’s current version of Plaintiff’s Website was published on October 9,
22 2010. However many of the texts that appear on Plaintiff’s Website were published
23 before July 2007.

24 22. On January 11, 2011 and January 20, 2011 Plaintiff applied for a copyright
25 registrations with the United States Copyright Office, which applications cover Plaintiff’s
26 Website and the texts that appear on Plaintiff’s Website.

27 23. As of the filing of this First Amended Complaint, Plaintiff’s copyright
28 application is pending before the United States Copyright Office.

Defendants' Disregard of Corporate Entities

24. On information and belief, Defendants IRAC and VRC (the "Corporate Defendants") are in substantially the same business as Plaintiff, renting cars and vans, including 15-passenger vans and Dodge "Sprinter" vans for tours, groups, and extended travel and long-term use. Notably, Plaintiff and the Corporate Defendants are some of the only companies to rent Dodge "Sprinter" vans in the country, and such vans are in high demand and attract corporate clients who can spend in excess of six figures renting them.

25. On information and belief, the Corporate Defendants' principal offices are in New York and have rental locations in New York, New Jersey, and Florida. On information and belief, the Corporate Defendants provide van rentals for use throughout the entire United States, including for use in California.

26. On information and belief, the Corporate Defendants own and operate the website imagerentacar.com.

27. On information and belief, the Corporate Defendants advertise and/or market their services to clients and potential clients located in California.

28. VRC is the alter ego of IRAC. IRAC has dominated the affairs of VRC and disregarded the separate identity of VRC, and IRAC has used VRC to perpetrate a fraud. VRC is completely lacking in any corporate formalities and paraphernalia that would be part and parcel of the existence of a bona fide corporation. VRC has no constitution, charters, or bylaws. VRC has no board of directors, has never held a board meeting, and has no board minutes. VRC has never issued any stock or kept records of its stockholders. VRC has never prepared or maintained any profit and loss statements, balance sheets, or other financial records, and on information and belief, was never capitalized. The Corporate Defendants have common ownership, common management, interrelated operations, and centralized control of employees, namely in the common control of day-to-day matters. On information and belief the Corporate Defendants have also commingled funds and assets, held out each entity as the other

1 entity, and have used the same offices and employees. On information and belief, the
2 Corporate Defendants have also used common credit cards, common websites, and
3 common email addresses. On information and belief, the Corporate Defendants used
4 the same computers, hosting services, and accounts to carry out their mutual online
5 business. There are no documents that evidence any formal relationship between the
6 Corporate Defendants or any other evidence that the Corporate Defendants dealt with
7 each other at arms length, even though an overt symbiotic relationship exists between
8 the Corporate Defendants.

9 29. Defendants Sebag and Zilberman (the "Individual Defendants") are or have
10 been employees, officers, and/or shareholders of the Corporate Defendants. On
11 information and belief, Sebag and Zilberman control the day-to-day operations of the
12 Corporate Defendants.

13 30. Sebag and Zilberman are the alter egos of both of the Corporate
14 Defendants. Sebag and Zilberman have disregarded the entities of the Corporate
15 Defendants, making the Corporate Defendants mere conduits for the transactions of the
16 Individual Defendants' own private business. The affairs of the Corporate Defendants
17 are so dominated by the Individual Defendants that the Corporate Defendants' business
18 has been primarily transacted for the Individual Defendants. As a result, separate
19 individualities between the Corporate Defendants on the one hand and the Individual
20 Defendants on the other hand have ceased to exist. The Individual Defendants have
21 failed to adopt any bylaws, charters, or constitutions for the Corporate Defendants. The
22 Individual Defendants have failed to keep any other corporate records that would be kept
23 by any bona fide corporation. The Individual Defendants have failed to adopt any board
24 of directors for the Corporate Defendants, and thus have not conducted any board
25 meetings or kept any board minutes. The Individual Defendants have failed to prepare
26 any profit and loss statements or balance sheets for the Corporate Defendants. On
27 information and belief, the Individual Defendants have failed to issue any stock on behalf
28 of the Corporate Defendants, and thus have not prepared any shareholder lists or other

1 shareholder documents. The Individual Defendants have used the offices and resources
2 of the Corporate Defendants for their own business and business conducted by third
3 party entities. And at least with respect to VRC, the Individual Defendants have failed to
4 file any tax returns.

5 31. As a result of the above, there is such unity of interest among all of the
6 Defendants that the separate personalities of the Corporate Defendants, and between
7 the Corporate Defendants on the one hand and the Individual Defendants on the other
8 hand, have ceased to exist.

9 **Defendants' Misconduct**

10 Defendants' Registration and Use of <bandago.net>

11 32. On information and belief, the Individual Defendants determine what
12 Internet domain names to register on behalf of the Corporate Defendants and how to use
13 those domain names. On information and belief, the Individual Defendants create and
14 maintain websites on behalf of the Corporate Defendants and associate those websites
15 with domain names the Individual Defendants register.

16 33. On information and belief, on or about August 28, 2008, defendant Sebag,
17 on behalf of the Corporate Defendants, registered the domain name bandago.net.

18 34. On information and belief, defendant Zilberman was aware of Sebag's
19 registration of the domain name bandago.net and Sebag's bad faith purpose in
20 registering it.

21 35. On information and belief, Zilberman and Sebag, in bad faith and on behalf
22 of the Corporate Defendants, created a website at the domain name bandago.net, which
23 automatically and immediately redirected visitors to defendant IRAC's website, located at
24 <imagerentacar.com>.

25 36. On information and belief, Defendants do not, and have never had, any
26 trademark or intellectual property rights in the name "Bandago."

27 37. On information and belief, the domain name bandago.net does not consist
28 of any name commonly used to identify Defendants.

1 38. On information and belief, other than in registering the domain name
2 bandago.net and redirecting visitors from bandago.net to their own website, Defendants
3 have never used the name "Bandago" in commerce or in connection with any bona fide
4 offering of any goods or services.

5 39. On information and belief, Zilberman and Sebag, on behalf of the Corporate
6 Defendants, registered and used the domain name bandago.net with the intent to divert
7 Plaintiff's actual or potential customers to Defendants' website with the desire and intent
8 that those redirected customers use Defendants' services instead of Plaintiff's.

9 40. The domain name bandago.net is confusingly similar to Plaintiff's Mark and
10 Plaintiff's Website bandago.com; except for the top level domains (*i.e.*, ".com" and ".net"),
11 Defendants' domain name is identical to Plaintiff's Mark and domain.

12 41. Defendants' website bandago.net caused actual confusion among
13 members of the public between Defendants' and Plaintiff's Websites and services.

14 42. On information and belief, actual or potential customers were actually
15 deceived by Defendants' use of the domain name bandago.net into using Defendants'
16 services instead of Plaintiff's services.

17 43. On information and belief, Defendants registered and used the domain
18 name bandago.net knowing that Plaintiff provided similar services under the Mark and
19 via its own website bandago.com and knowing that it would likely harm Plaintiff. On
20 information and belief, Defendants took these actions also knowing that Plaintiff's
21 principal place of business was in California and that such actions would likely harm
22 Plaintiff in California.

23 44. As a result of Defendants' misconduct, Plaintiff has been substantially
24 harmed.

25 Defendants' Trademark Infringement by Keyword Advertising on the BANDAGO Mark

26 45. AdWords is a service provided by Google, Inc. through which advertisers
27 purchase terms (or keywords) that will trigger the display of their ads in Google search
28 results.

1 46. When an advertiser bids on a keyword, and when an Internet user enters
2 that keyword into the Google search engine, the keyword triggers the appearance of the
3 advertiser's ad in the search results. Specifically, the Google search engine presents an
4 ordered list of relevant websites identified by the Google database with the most relevant
5 website listed first. The Google search engine also presents a separate list of websites
6 in a "Sponsored Links" section, either at the top or in the right margin of the search-
7 results screen.

8 47. When a user clicks on an ad, the user is taken to the advertiser's website.

9 48. Advertisers pay Google based on the number of times Internet users click
10 on their advertisements.

11 49. Since before 2008, Defendants have used Google's AdWords service to bid
12 on multiple keywords, spending thousands of dollars in their online marketing campaign.

13 50. Beginning in 2008, and without Plaintiff's consent, Defendants bid on
14 several variations of the BANDAGO Mark in AdWords, namely "Bandago," "Bandago Van
15 Rentals," and "Bandago Van Rental."

16 51. When a user searched on the BANDAGO Mark in the Google search
17 engine, Defendants paid Google to display advertisements for Defendants' van rental
18 services in the search results. And when a user clicked on Defendants' advertisement,
19 the user was taken to Defendants' website, which offered van rental services.

20 52. As a result of Defendants' bidding on the BANDAGO mark, users who
21 searched for Plaintiff's Website were diverted to Defendants' competitive website.

22 53. Moreover, as a result of Defendants' misconduct, actual confusion occurred
23 about the relationship between Plaintiff and Plaintiff's services on the one hand and
24 Defendants and Defendants' services on the other hand. This confusion occurred
25 because users who had searched on the BANDAGO mark were looking for and expected
26 to find Plaintiff's Website or information about Plaintiff's services. Instead, such users
27 were diverted to Defendants' website.
28

54. Defendants' infringement through keyword bidding was not limited to the BANDAGO Mark. Defendants engaged in a pattern and practice of bidding on third parties' trademarks for competitive van and car rental services.

55. As a result of Defendants' misconduct, Plaintiff has been substantially harmed.

Defendants' Copyright Infringement

56. On information and belief, without any license or permission, Defendants copied multiple original texts from Plaintiff's Website, which texts are covered by Plaintiff's copyright applications (collectively, "Plaintiff's Texts").

57. Plaintiff's Texts were first published before July 2007.

58. As examples, Defendants copied, altered, and displayed the following texts on Defendants websites, which texts are covered by Plaintiff's copyright application:

- "Are you planning a tour or long trip for your group? Need a van that is big enough and comfortable enough for an extended travel period?"
- "The Ford Econoline XLT extended 15 Passenger van is the standard workhorse for touring groups across America. It is by far the most popular van in the United States, and has achieved it's hard fought for dominance by delivering dependable performance year after year. Our Ford vans are all equipped with tow hitch receivers, so should you need to tow a trailer to carry your gear, we can accomodate you."
- "Our new sprinter vans are the wave of the future. With loads of room (you can stand up in them), and comfortable seating, this is the way to go if you are going to be traveling in a van for an extended period. Popular in Europe for many years."
- "Road vibrations, normal wear and tear, misuse, even car washes can all lead to the AV system malfunctioning."
- "We provide power outlets for the game systems and your personal use. However please keep in mind that these do not supply *unlimited* power. If you plug too many things into our outlets you will either blow a fuse or melt the inverter. Keep

an eye on how many cell phone chargers are plugged into the system, and make sure you disconnect them from the power supply if your phone is fully charged. Often we run into problems when 5 or 6 people have each of their cell phone chargers plugged in, both x-boxes running, and then they plug in a couple laptops and melt the inverter. Most of our vans have at least 1000 watts of power. This should be more than enough for normal day to day use.”

- “All of our vans come equipped with a large LCD video screen, DVD player, Video game system (video game library included!), iPod Support, Remote Entry, Tinted Windows, Cruise Control, Power Locks, Power Windows, Power Mirrors, and more. And for a small additional fee we can provide you with a GPS system.”
- “We provide a video/game system in all of our vehicles as an amenity to our clients. We do everything in our power to make sure the AV system is in working order before you leave, and if you find that something is broken during your rental, we will do everything in our power to get it repaired as soon as your schedule permits. However it is important to keep a couple things in mind: AV systems are easy to break. Road vibrations, normal wear and tear, misuse, even car washes can all lead to the AV system malfunctioning. If your AV system does not work for some reason, please contact us, and we will schedule an appointment to get it repaired at the nearest Stereo/Alarm store your schedule will permit. Due to the fact that the typical breakdown is beyond our control we do not offer discounts due to a AV system breakdown.”
- “We provide power outlets for the game systems and your personal use. However please keep in mind that these do not supply unlimited power. If you plug too many things into our outlets you will either blow a fuse or melt the inverter. Keep an eye on how many cell phone chargers are plugged into the system, and make sure you disconnect them from the power supply if your phone is fully charged. Often we run into problems when 5 or 6 people have each of their cell phone chargers plugged in and then they plug in a couple laptops and melt the inverter.

1 Most of our vans have at least 1000 watts of power. This should be more then
2 enough for normal day to day use.”

3 59. Defendants altered Plaintiff’s Texts after copying Plaintiff’s Texts from
4 Plaintiff’s Website.

5 60. Without any license or permission, Defendants displayed Plaintiff’s Texts on
6 Defendants’ websites in connection with Defendants’ products and services.

7 61. On information and belief, Defendants engaged in this copying, alteration,
8 and display of Plaintiff’s Texts with knowledge that Plaintiff owned the copyrights to
9 Plaintiff’s Texts, and that Defendants were infringing on these copyrights.

10 62. On information and belief, the Defendants’ websites, which displayed
11 Plaintiff’s Texts, have been viewed by thousands of customers and potential customers
12 during the period in which the website displayed Plaintiff’s Texts.

13 63. As a result of Defendants’ misconduct, Plaintiff has been substantially
14 harmed.

15 FIRST CLAIM FOR RELIEF

16 Cybersquatting [Lanham Act §43(d); 15 USC §1125(d)(1)]

17 64. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-63, as if
18 fully alleged herein.

19 65. Plaintiff is the owner of the Mark.

20 66. The Mark is distinctive.

21 67. Defendants, in bad faith, intended to profit from the Mark by registering,
22 trafficking in, and/or using the domain name bandango.net, which contains the Mark.

23 68. At the time Defendants registered the domain name www.bandango.net, it
24 was identical, or confusingly similar, to the Mark.

25 69. As a direct and proximate result of Defendant’s actions, conduct, and
26 practices alleged above, Plaintiff has been damaged and will continue to be damaged.

27 70. Defendants’ acts have also caused and are causing irreparable and
28 incalculable injury to Plaintiff and its Mark, and to the business and goodwill represented

thereby, and unless enjoined, will cause further irreparable and incalculable injury, whereby Plaintiff has no adequate remedy at law.

SECOND CLAIM FOR RELIEF

Unfair Competition [Lanham Act §43(a), 15 U.S.C. §1125(a)]

71. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-70, as if fully alleged herein.

72. Plaintiff is the owner of the Mark.

73. The Mark is distinctive.

74. Defendants registered and used in commerce the domain name bandago.net.

75. Defendants' registration and use in commerce of the domain name bandago.net, including its redirecting of visitors to bandago.net to Defendants' website, is likely to cause confusion, to cause mistake, or to deceive members of the public, including potential and current clients of Plaintiff, as to the source and origin of the services offered and to be offered by Defendants under the domain name bandago.net.

76. Defendants' registration and use in commerce of the domain name bandago.net constitutes trademark infringement of Plaintiff's common law trademark rights in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

77. As a direct and proximate result of Defendant's actions, conduct, and practices alleged above, Plaintiff is likely to be and has been damaged and will continue to be damaged.

78. Defendants' acts have also caused and are causing irreparable and incalculable injury to Plaintiff and its Mark, and to the business and goodwill represented thereby, and unless enjoined, will cause further irreparable and incalculable injury, whereby Plaintiff has no adequate remedy at law.

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THIRD CLAIM FOR RELIEF

False Advertising [Lanham Act §43(a), 15 U.S.C. §1125(a)(1)(B)]

79. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-78, as if fully alleged herein.

80. Plaintiff is the owner of the Mark.

81. The Mark is distinctive.

82. Defendants registered and used in commerce the domain name bandago.net.

83. Defendants' registration and use in commerce of the domain name bandago.net, including its redirecting of visitors to bandago.net to Defendants' website, constitutes commercial advertising or promotion within the meaning of Section 43(a)(a)(B) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

84. Defendants' registration and use in commerce of the domain name bandago.net misrepresents the nature, characteristics, and qualities of Defendants' and Plaintiff's goods, services, and commercial activities.

85. As a direct and proximate result of Defendant's actions, conduct, and practices alleged above, Plaintiff is likely to be and has been damaged and will continue to be damaged.

86. Defendants' acts have also caused and are causing irreparable and incalculable injury to Plaintiff and its Mark, and to the business and goodwill represented thereby, and unless enjoined, will cause further irreparable and incalculable injury, whereby Plaintiff has no adequate remedy at law.

FOURTH CLAIM FOR RELIEF

Common Law Trademark Infringement

87. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-86, as if fully alleged herein.

88. Plaintiff is the owner of the Mark.

89. The Mark is distinctive.

1 90. Plaintiff used the Mark in commerce continuously and exclusively prior to
2 Defendants' use of the Mark.

3 91. Defendants' registration and use in commerce of the domain name
4 bandago.net, including its redirecting of visitors to bandago.net to Defendants' website, is
5 likely to cause confusion, to cause mistake, or to deceive members of the public,
6 including potential and current clients of Plaintiff, as to the source and origin of the
7 services offered and to be offered by Defendants under the domain name bandago.net
8 and to cause members of the public to confuse Defendants' use of "bandago" with
9 Plaintiff's Mark.

10 92. As a direct and proximate result of Defendant's actions, conduct, and
11 practices alleged above, Plaintiff has been damaged and will continue to be damaged.

12 93. In committing the conduct and acts alleged herein, Defendants have acted
13 despicably, and have been guilty of oppression, fraud, and/or malice, and acted with a
14 willful and conscious disregard for Plaintiff's rights, and with intent to deceive.

15 **FIFTH CLAIM FOR RELIEF**

16 **Unlawful, Unfair, or Fraudulent Business Practices [Cal. Bus. & Prof. C. §17200]**

17 94. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-93, as if
18 fully alleged herein.

19 95. Plaintiff is the owner of the Mark.

20 96. The Mark is distinctive.

21 97. Defendants' registration and use in commerce of the domain name
22 bandago.net, including its redirecting of visitors to bandago.net to Defendants' website,
23 are unlawful business practices in violation of Sections 43(a) and 43(d) of the Lanham
24 Act.

25 98. Defendants' registration and use in commerce of the domain name
26 bandago.net, including its redirecting of visitors to bandago.net to Defendants' website,
27 are unfair and/or fraudulent business practices that are designed to deceive, confuse,
28 and misguide members of the public, including Plaintiff's actual and potential customers,

1 as to owner of the Bandago brand and the source of services provided under the
2 Bandago brand, and are designed to siphon, redirect, and improperly take Plaintiff's
3 actual and potential customers for Defendants' own commercial gain and to the detriment
4 of Plaintiff.

5 99. As a direct and proximate result of Defendant's actions, conduct, and
6 practices alleged above, Defendants have acquired improper commercial benefits and
7 Plaintiff has been damaged and will continue to be damaged.

8 100. In committing the conduct and acts alleged herein, Defendants have acted
9 despicably, and have been guilty of oppression, fraud, and/or malice, and acted with a
10 willful and conscious disregard for Plaintiff's rights, and with intent to deceive.

11 **SIXTH CLAIM FOR RELIEF**

12 **(COPYRIGHT INFRINGEMENT, VICARIOUS COPYRIGHT INFRINGEMENT, AND**
13 **CONTRIBUTORY COPYRIGHT INFRINGEMENT 17 U.S.C. §501 et seq.)**

14 101. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-100, as
15 if fully alleged herein.

16 102. Plaintiff's Texts are original, creative works in which Plaintiff owns
17 protectable copyright interests.

18 103. Plaintiff first published Plaintiffs' Texts before July 2007, and first published
19 the current version of Plaintiff's Website, containing Plaintiff's Texts on October 9, 2010.

20 104. Plaintiff owns the copyright for Plaintiff's Texts and has applied for a
21 copyright registration with the United States Register of Copyrights covering Plaintiff's
22 Texts.

23 105. Plaintiff has not licensed Defendants to use Plaintiff's Texts in any manner,
24 nor has Plaintiff assigned any of its exclusive rights in its copyrights to Defendants.

25 106. Without permission or authorization from Plaintiff, and in willful violation of
26 Plaintiff's rights under 17 U.S.C. §106, Defendants reproduced Plaintiff's Texts.

27 //

28 //

107. Without permission or authorization from Plaintiff, and in willful violation of Plaintiff's rights under 17 U.S.C. §106, Defendants prepared derivative works based on Plaintiff's Texts.

108. Without permission or authorization from Plaintiff, and in willful violation of Plaintiff's rights under 17 U.S.C. §106, Defendants displayed Plaintiff's Texts on Defendants' websites.

109. Defendants' reproduction of Plaintiff's Texts, preparation of a derivative work based on Plaintiff's Texts, and display of Plaintiff's Texts on Defendants' websites constitute copyright infringement.

110. On information and belief, thousands of customers and potential customers of Plaintiff and Defendants have viewed the unlawful copies of Plaintiff's Texts on Defendants' websites.

111. On information and belief, all Defendants had knowledge of the copyright infringement alleged herein and had the ability to stop the reproduction, alteration, and display of Plaintiff's copyrighted materials.

112. On information and belief, all Defendants provided substantial assistance in the copyright infringement.

113. Plaintiff is serving notice of this action on the Register of Copyright at the same time Plaintiff is filing this complaint with the Court, and thus Plaintiff is entitled to institute this action for copyright infringement.

114. Defendants' copyright infringement has damaged Plaintiff in an amount to be proved at trial.

SEVENTH CLAIM FOR RELIEF

(INFRINGEMENT OF AN UNREGISTERED TRADEMARK 15 U.S.C. §1125(a))

115. Plaintiff re-alleges and incorporates herein the above Paragraphs 1-114, as if fully alleged herein.

116. Plaintiff is the owner of the BANDAGO Mark.

117. The BANDAGO Mark is distinctive and entitled to trademark protection.

118. Without Plaintiff's knowledge or consent, Defendants bid on keywords comprising and including the BANDAGO Mark in the Google AdWords service.

119. Defendants bid on these keywords knowing that they comprised Plaintiff's trademark and with an intent to divert Plaintiff's customers to Defendants' website.

120. Defendants thus used Google AdWords to display ads for their competitive van rental service when users performed Google searches on the BANDAGO Mark.

121. Users who searched on the BANDAGO Mark expected to find Plaintiff's Website or information about Plaintiff's services.

122. By bidding on the BANDAGO mark in Google Adwords, Defendants diverted users looking for Plaintiff's Website to Defendants' website.

123. As a result of Defendants' misconduct, users who searched on the BANDAGO mark were confused about the relationship between Plaintiff and Plaintiff's services on the one hand and Defendants and Defendants' services on the other hand.

124. As a direct and proximate result of Defendants' actions, conduct, and practices alleged above, Plaintiff has been damaged and will continue to be damaged.

125. Defendants' acts have also caused and are causing irreparable and incalculable injury to Plaintiff and its Mark, and to the business and goodwill represented thereby, and unless enjoined, will cause further irreparable and incalculable injury, whereby Plaintiff has no adequate remedy at law.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests judgment as follows:

1. That the Court enter judgment against the Defendants that they have:
 - a. Committed and are committing cybersquatting in violation of 15 U.S.C. §1125(d);
 - b. Committed and are committing acts of infringement of an unregistered trademark and unfair competition in violation of 15 U.S.C. §1125(a);

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- c. Committed and are committing acts of infringement of Plaintiff's trademark under California law;
 - d. Committed and are committing acts of unfair competition in violation of California Business & Professions Code section 17200;
 - e. Committed and are committing copyright infringement in violation of 17 U.S.C. §501 *et seq.*; and
 - f. Committed have committed trademark infringement in violation of 15 U.S.C. §1125(a);
2. That the Court issue injunctive relief against Defendants, requiring Defendants to transfer the domain name bandango.net to Plaintiff and to remove Plaintiff's copyrighted materials from all media Defendants possess or control;
 3. That the Court order Defendants to pay Plaintiff's damages as follows:
 - a. The greater of Plaintiff's damages (composed of Plaintiff's actual damages and Defendant's profits) in an amount to be determined according to proof pursuant to or Plaintiff's statutory damages of \$100,000 pursuant to 15 U.S.C. §1117(a), (d);
 - b. Plaintiff's damages (composed of Plaintiff's actual damages and Defendant's profits) in an amount to be determined according to proof pursuant to 15 U.S.C. §1117(a) for Defendant's willful infringement of Plaintiff's unregistered trademark;
 - c. Plaintiff's restitutionary damages for Defendant's violation of California Business and Professions Code section 17200;
 - d. Plaintiff's damages (composed of Plaintiff's actual damages and Defendant's profits) in an amount to be determined at trial, including three times the amount found as actual damages by the trier of fact under 17 U.S.C. §504(a) and (b) or Plaintiff's statutory damages of \$150,000 pursuant to 17 U.S.C. §504(c);

- 1 e. Plaintiff's costs and attorneys' fees pursuant to 15 U.S.C. §1117(a)
2 and 17 U.S.C. §505;
3 f. Such other damages as the Court shall deem appropriate; and
4 g. Interest, including prejudgment interest, on the foregoing sums; and
5 4. That the Court grant to Plaintiff such additional relief as is just and proper.

6
7 Respectfully Submitted,

8
9 DATED: March 21, 2011.
10

11 **KRONENBERGER BURGOYNE, LLP**

12
13 By: s/ Karl S. Kronenberger

14 Karl S. Kronenberger

15 Attorneys for Plaintiff DIGBY ADLER
16 GROUP d/b/a BANDAGO
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REQUEST FOR JURY TRIAL

Plaintiff hereby demands a trial of this action by jury.

DATED: March 21, 2011.

KRONENBERGER BURGOYNE, LLP

By: s/ Karl S. Kronenberger

Karl S. Kronenberger

Attorneys for Plaintiff DIGBY ADLER
GROUP d/b/a BANDAGO